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In the Supreme Court of the United States

OCTOBER TERM, 1943.

No. 169

THE I. T. S. COMPANY,
Petitioner,

v.

SEIBERLING RUBBER COMPANY,
and
THE SEIBERLING RUBBER COMPANY,
Respondents.

PETITION FOR A WRIT OF CERTIORARI
To the United States Circuit Court of Appeals
For the Sixth Circuit, and
BRIEF IN SUPPORT OF PETITION.

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PETITION FOR A WRIT OF CERTIORARI
To the United States Circuit Court of Appeals
For the Sixth Circuit.

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioner, The I. T. S. Company, respectfully prays that a writ of certiorari issue to review a judgment of the United States Circuit Court of Appeals for the Sixth Circuit, entered April 12, 1943 (re-hearing denied June 2, 1943) in the above entitled cause.

The transcript of the record, including the proceedings in the Circuit Court of Appeals, has been filed herein pursuant to Rule 38.

(A)

SUMMARY STATEMENT OF THE MATTER INVOLVED.

In this suit by petitioner for infringement of a patent relating to an invention in the shoemaker's art, infringement is found by duplication, by both the District Court and the Court of Appeals. No anticipation is found by either Court. The sole question remaining is the question of mechanical skill and invention. The District Court determined this question *objectively* by the nature of the contribution to the advancement of the art, and found invention present; the Court of Appeals determined the question *subjectively*, holding that invention was absent and reversing the District Court. Furthermore, the Court of Appeals determined the question subjectively on considerations relating to an art alien to the art to which the invention relates, without evidence on the subject, and in the face of objection to and exclusion of evidence on the subject in the District Court.

The evidence upon which the District Court found the presence of invention on the *objective* tests included evidence of long standing want and need for the invention; many prior efforts and failures by those skilled in the art to which the invention relates to solve the problem solved by the patentee; public adoption; commercial success; a new mode of operation; achievement of new and useful results, and the achievement of old results in a better way, all of which had long been desired; and duplication of the invention by respondent and the entire industry. Although the Court of Appeals recognized the presence of this evidence and these factors on the objective test, and the fact that the District Court had determined the question of invention and mechanical skill objectively, the Court of Appeals reversed the finding notwithstanding the evidence and determined it by the subjective test, holding that in the opinion of the Court of Appeals the invention was "obvious" to those working in the rubber industry, an

industry alien to the shoemaker's industry. The Court of Appeals did not find that the invention was obvious to those skilled in the shoemaker's art.

Plaintiff proffered evidence to the effect that the invention was not obvious to those skilled in the rubber manufacturer's art, but such evidence was objected to and excluded (R. p. 57).

On December 12, 1941, the President of the United States issued an Executive Order establishing the National Patent Planning Commission "to conduct a comprehensive survey and study of the American patent system," to report upon its accomplishments, past, present, and prospective, upon its value, and to make recommendations to improve upon the same and to obviate "obstructions" to the performance of its intended functions. The Commission was appointed and made extensive investigations, reporting in June, 1943* that the American patent system had been most valuable to the people of the United States, was still valuable, and should be continued. The Commission made certain recommendations for modifying the system and pointed out that one of the "obstructions" to the proper operation of the system was the confusion and babel among the Courts on the question of invention and mechanical skill, recommending that this question "be determined *objectively* by the nature of the contribution to the advancement of the art," and that there be a declaration of policy to that effect, going so far as to recommend that if this could not be done otherwise, Congress might pass a law so legislating. We are informed that this report has been approved by President Roosevelt. (We will discuss these matters more in detail in the argument.)

As this report was handed down in June, 1943, the instant case is the first case brought to this Court since

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* Published in Advance Sheets, U. S. Pat. Q., Vol. 57, Special Edition, June 19, 1943.

the report was handed down presenting this question to this Court on a diversity of decisions on the subject between the District Court and the Court of Appeals, where the District Court decided the question "*objectively*" by fact findings on the evidence on the basis recommended by the Commission, and was reversed by the Court of Appeals, who decided it "*subjectively,*" without regard to the evidence as the facts found, on the basis condemned by the Commission. Manifestly, there will be no need of a law of Congress on the subject if this Court would determine the question in the instant case in conformity with the recommendations of the Commission by affirming the District Court and overruling the Court of Appeals, and thereby interpreting the existing laws in such a way as to make it unnecessary to amend or supplement the law, all of which is invited by the Commission.

There is, therefore, diversity of decision between the Court of Appeals in the Sixth Circuit and the District Court in this case on a question made of great public interest by the President's Commission.

It is manifestly a matter of far-reaching importance from the standpoint of the public interest to determine whether the question of invention and mechanical skill is to be determined "*objectively,*" as the National Patent Planning Commission has recommended, or "*subjectively,*" contrary to their recommendations. It is also of great public interest to know if it is going to be necessary for Congress to pass a law on this subject, and if the public must wait until Congress can pass such a law to obtain the benefits of such a policy as the Commission recommends.

It is a matter of great public interest to know whether the test for mechanical skill and invention is the same in all arts. In the particular instance—whether the tests for mechanical skill and invention in the shoemaking art is the same as that in the rubber manufacture art. It is also of great public interest to know if a patent can be held

invalid on the theory that the invention is obvious in an art to which the invention does not relate when it is not pleaded and when the evidence on the subject has been excluded, and whether or not that question is to be determined without the benefit of evidence on the subject.

(B)

REASONS RELIED UPON FOR THE ALLOWANCE OF THE WRIT.

(1) There is diversity of decision between the Courts below on the following questions:

(a) The District Court decided the question of invention and mechanical skill "objectively" as the National Patent Planning Commission recommends, and the Court of Appeals determined the question "subjectively," which the said Commission condemns.

(b) Where an invention relates to the shoemaker art, may the question of mechanical skill and invention be determined and gauged by what is obvious or unobvious in the rubber manufacturer's art? The District Court decided the question on the basis of the art to which the invention relates; the Court of Appeals decided it on the basis of an alien art.

(c) Since the act was not within the ruck or skill of those in the shoemaker's art, it is immaterial whether or not it was obvious to those skilled in the rubber manufacturer's art. The District Court so ruled in excluding, at the instance of respondent, evidence as to the unobviousness of the invention in the rubber manufacturer's art; the Court of Appeals held the contrary without remanding or giving petitioner an opportunity to put in the excluded evidence.

(2) It is of great public interest and importance that this Court should dispel the confusion that exists and settle the following questions:

(a) The question of invention and mechanical skill should be determined "objectively," as the District Judge did, and not "subjectively," as the Court of Appeals did, and this Court should declare a policy to that effect so that there will be no need that Congress should pass a law to that effect as the National Patent Planning Commission recommends.

(b) May that which is not within the skill or the ruck of those skilled in the art to which it relates, and which constitutes invention in that art, be held to be non-inventive because it may be thought "subjectively" to be obvious to those in other arts? In other words, are the same tests to be applied in all the arts? Is the test the same for the cobbler, the rubber manufacturer, the chemist, the electrical engineers, and all others?

(c) Is it proper, when evidence on the fact question of the alleged obviousness in the alien art has been objected to by defendant and excluded by the trial Court, for the reviewing Court to hold the inventor's act obvious in the alien art in the absence of the excluded evidence?

(d) Is it proper to hold the act of the inventor within the skill of the alien art when that allegation has not been pleaded or made an issue in the cause?

(e) The case should be remanded and reopened to admit the excluded evidence on the subject if the question is to be determined on the basis of the alien art.

(3) There is diversity of decision between the various Courts of Appeals, some holding to the decision of the

question of patentable invention "objectively," and some "subjectively."

(4) There is diversity of decision between the Courts of Appeals on the question of the standard of invention which this Court has established or desires to establish.

Respectfully submitted,

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BRIEF IN SUPPORT OF PETITION.

I.

THE OPINIONS OF THE COURTS BELOW.

The opinion of the District Court is reported in 53 U. S. P. Q. 627, and is reproduced at pages 431 to 438 of the Record. The District Court's Findings of Fact and Conclusions of Law are reproduced at pages 454 to 458 of the Record.

The opinion of the Sixth Circuit Court of Appeals is reported in 134 F. (2) 871, and is reproduced at pages 484 to 490 of the Record.

II.

JURISDICTION.

1. This is a suit arising under the patent laws of the United States, 28 U. S. C. 41 (7). Jurisdiction is given this Court by 28 U. S. C. 347. (Sec. 240 (a) of the Judicial Code as amended by the Act of February 13, 1925.)

2. The date of the judgment which petitioner seeks to have reviewed is April 12, 1943. (R. p. 483.) Rehearing was denied June 2, 1943. (R. p. 511.)

3. Among the cases believed to sustain jurisdiction to issue the writ, where questions of federal law of far-reaching public importance are involved, even where there is no specific conflict between different circuits, are:

Exhibit Supply Co. v. Ace Patents Corp., 315 U. S. 126;

Muncie Gear Works v. Outboard Marine & Mfg. Co., 315 U. S. 759.

4. Among the recent cases in which the court has issued the writ of certiorari where there is diversity of decision between the District Court and the Court of Appeals are:

Paramount Publix v. Tri-Ergon, 294 U. S. 464;
Duplate v. Triplex, 298 U. S. 448.

5. This Court has always and consistently reviewed questions on which courts of appeals below are in dispute.

III.

SUMMARY OF ARGUMENT.

Point A: The District Court decided the question of the presence of invention, the only issue in the case, "objectively," in accordance with the recommendation of the National Patent Planning Commission appointed by President Roosevelt; the Court of Appeals reversed the District Court, deciding the question "subjectively" and, therefore, contrary to the recommendation of such Commission. The decision of the Court of Appeals should be reversed and the recommendations of the Commission should be adopted and followed.

Point B: The Court of Appeals decided the question of invention "subjectively" from the standpoint of what

would be "obvious" to the workers in an art different from that to which the patent relates. In so doing, the Court decided the case on an issue not made up by the pleadings, upon which no evidence was offered by respondent, and upon which evidence proffered by petitioner was objected to and excluded. The Court of Appeals should have remanded the case for evidence and findings on this issue before deciding the case upon it.

IV.

ARGUMENT.

Point A.

Manifestly, nothing in the patent law could be so important to the public now as rulings by this Court which would bend the patent law and conform the practice at the Bar and Bench to the recommendations of the National Patent Planning Commission and make it unnecessary for Congress to pass laws whose only effect would be the interpretation of present laws and which rulings of this Court would gain the advantages of such laws without waiting for their passage.

As we have said, the President issued an Executive Order in 1941 to establish this Commission for the following purposes, as stated in that order:

> "2. The Commission is authorized, in conjunction with the Department of Commerce, to conduct a comprehensive survey and study of the American patent system, and consider whether the system now provides the maximum service in stimulating the inventive genius of our people in evolving inventions and in furthering their prompt utilization for the public good; whether our patent system should perform a more active function in inventive development; *whether there are obstructions in our existing system of patent laws, and if so, how they can be eliminated*; to what extent the Government should go in stimulating inventive effort in normal times; and what methods and

plans might be developed to promote inventions and discoveries which will increase commerce, provide employment, and fully utilize expanded defense industrial facilities during normal times." (Emphasis ours throughout.)

The President then appointed the following members of the Commission:

Chairman, Charles F. Kettering, an outstanding practical engineer-scientist of our time.

Chester C. Davis, who needs no introduction to this Court.

Francis P. Gaines, the President of Washington-Lee University, and an educator of great skill and prominence.

Edward F. Grady, who needs no introduction to this Court, and

Owen D. Young, also highly skilled in business and in engineering and science.

This Commission conducted numerous hearings, taking testimony from those skilled in all branches of engineering, science, law, and allied subjects, some of whom were in favor and some against the patent system. Its survey was comprehensive and its study profound. In June, 1943, it handed down its Report to the effect that the American patent system is the foundation of American enterprise, has demonstrated its value, has stimulated invention, made the American people and Government leaders in the world, and that it should be continued. We quote from the Report of the Commission, as follows:

"1. The Patent System of the United States. The Patent System is the foundation of American enterprise and has demonstrated its value over a period coextensive with the life of our government. The principle of recognizing a property right in intellectual creation is sound and should be continued as contemplated in the Constitution."

* * * * *

"The American patent system established by the Constitution giving Congress the 'power to promote the progress of science and useful arts,' is over 150 years old. The system has accomplished all that the framers of the Constitution intended. It is the only provision of the government for the promotion of invention and discovery and *is the basis upon which our entire industrial civilization rests.*

"The American people and their government should recognize the fundamental rightness and fairness of protecting the creations of its inventors by the patent grant. The basic principles of the present system should be preserved. *The system has contributed to the growth and greatness of our nation*; it has:

(1) encouraged and rewarded inventiveness and creativeness, producing new products and processes which have *placed the United States far ahead of other countries in the field of scientific and technological endeavor;*

(2) stimulated American inventors *to originate a major portion of the important industrial and basic inventions of the past 150 years;*

(3) facilitated the rapid development and general application of new discoveries in the United States *to an extent exceeding that of any other country*;

(4) contributed to the achievement of the highest standard of living that any nation has ever enjoyed;

(5) *stimulated creation and development of products and processes necessary to arm the nation and to wage successful war*;

(6) contributed to the improvement of the public health and the public safety; and

(7) operated to protect the individual and small business concerns during the formative period of a new enterprise.

"*The strongest industrial nations have the most effective patent systems and, after a careful study, the Commission has reached the conclusion that the Ameri-*

can system is the best in the world. However, as with any system of long standing, conditions arise which were not foreseen at the time of its establishment. *The American patent system should be adjusted to meet existing conditions without destroying its basic principles.*"

After noting that the American patent system had not only not interfered with the war effort, but had helped that effort, the Commission proceeded to make recommendations for adjustment of the system which would bring it abreast of existing conditions and make it more helpful to the American people and the American Government. Among these of particular interest here is the one which recommended the determination of the question of invention and mechanical skill "objectively" and not "subjectively." The portion of the Report which deals with this subject is as follows:

"V—UNIFORM STANDARD OF INVENTION

"A. Declaration of National Policy.

"*The most serious weakness in the present patent system is the lack of a uniform test or standard for determining whether the particular contribution of an inventor merits the award of the patent grant.* The patent statute itself is quite specific. R. S. 4886 provides that a patent may be obtained by 'any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, * * * upon payment of the fees required by law and other due proceedings had.' The difficulty of applying this statute arises out of the presence of the words 'invented' and 'discovered.' Novelty alone is not sufficient, nor is utility, nor is the final accomplishment. There must also be present some mysterious ingredient connoted in the term 'invented.'

"*Many different and unrelated tribunals now are forced to make their individual decisions,* among them being the Patent Office, the several district courts, the various courts of Appeals and the Supreme Court.

The difficulty is that there is no accepted uniform standard among these several tribunals which can be applied in the same or similar cases. There is an ever widening gulf between the decisions of the Patent Office in granting patents and decisions of the courts who pass upon their validity. It would be highly desirable and a great step forward if patents could be issued with a greater assurance that their validity would be upheld by the courts. *No other feature of our law is more destructive to the purpose of the patent system than this existing uncertainty as to the validity of a patent.* The admonition is frequently heard that there should be 'fewer and better patents,' an impossible accomplishment so long as the present divergence of standards between the Patent Office and the courts and the several courts themselves obtains. Whether the standard of the Patent Office is too low or that of the courts is too high is not for us to determine. *There should be a uniformity in the grant and treatment of patents. The present confusion threatens the usefulness of the whole patent system and calls for an immediate and effective remedy.*

"It is inconsistent with sound national policy to continue to grant patents with existing uncertainty as to their validity, and unfair to the inventors of this country and to manufacturers and inventors who have proceeded on the basis of a protective security in the form of a patent issued to them by the Federal Government. The Commission feels that not one but several steps should be taken to remedy the present situation. A promising improvement would be for Congress, by legislative enactment, to lay down a reasonable, understandable test by which inventions shall be judged both from the standpoint of the grant of the patent and the validity of the patent thereafter.

"The Commission therefore recommends the enactment of a declaration of policy that patentability shall be determined objectively by the nature of the contribution to the advancement of the art, and not subjectively by the nature of the process by which the invention may have been accomplished."

> We call particular attention to the recommendation of "the enactment of a declaration of policy that patentability shall be determined objectively" and not "subjectively,"

appended to the above recommendation and that this should be done immediately and effectively. This can only be construed as an invitation to this Court to enact such a declaration of policy since it is within the power of this Court to do so, thereby stilling the controversy that has raged on this subject, as the Commission points out, over many years, among the various tribunals to whom the subject is presented and furnishing the inventing public, the engineering and scientific peoples, the patent bar, the patent Courts, and business, with a rule or yardstick upon which some dependence can be placed.

It is equally manifest that the stilling of this controversy should be done expeditiously and without the need of enactment by Congress as the Commission suggests might be resorted to as a last resort.

The instant case presents the question squarely and offers an opportunity for a prompt enactment of a declaration of the policy without the need of a law of Congress.

There is at Present Diversity of Decisions between the Courts of Appeals (in the 7th and 2nd Circuits for Example) About the Use of the "Objective" or the "Subjective" Tests:

There has been a long and intense struggle among the various Courts below at circuit and in district concerning the use of the objective test and the subjective test; at the present time there is a diversity of decision among the Courts of Appeals as to its application, some holding to the objective view and some to the subjective view. The interpretation of all the Courts has been that a decision objectively is predicated upon the history and a decision subjectively is based upon the "divination" of the Court. We

find such comments and holding on the subject as the following among the various courts:

In *Wahl Clipper Corporation v. Andis Clipper Co., et al.*, 66 Fed. (2) 162, Judge Alschuler for the Court of Appeals in the Seventh Circuit said (p. 165):

> "In most instances, the judgment of those who pay their money to secure the benefits of the patented article is truer and better than the opinion of experts or the speculations of an arbitrator. Inasmuch as experience is more reassuring than theorizing, and history more certain than prophecy, so the test of public approval, if uninfluenced by detracting factors, must afford the weightiest proof obtainable determinative of invention. In short, in construing the patent statute, which was enacted to promote the useful arts, it is more important to study those developments of the art which are bright with use in the channels of trade than to delve into abandoned scrap heaps and dust-covered books which tell of hopes unrealized and flashes of genius quite forgotten. The somewhat meaningless terms 'inventive genius' and 'mechanical skill' must be clarified by an examination of the article itself, and if the improvement be unusual, or if there be doubt, and the public has given its tribute, the judge should accord to the creator of the article the title of inventor."

This is the objective test and its application.

Contrast these pronouncements of the practice in the Seventh Circuit with the following pronouncement of the practice in the Second Circuit in *Kirsch v. Gould*, 6 Fed. (2) 793, 794:

> "Yet, when all is said, there will remain cases when we can only fall back upon such good sense as we may have, and in these we cannot help exposing the inventor to the hazard inherent in hypostatizing such modifications in the existing arts as are within the limited imagination of the journeyman. There comes a point when the question must be resolved by a subjective opinion as to what seems an easy step and what does

not. We must try to correct our standard by such objective references as we can, but in the end the judgment will appear, and no doubt be, to a large extent personal, and in that sense arbitrary."

There is Diversity of Decision Among the Courts of Appeals Below as to What Standard of Invention This Court Has Set or Desires Shall be Set: There seems to be a consensus of opinion that this Court has changed the standard of invention, but a variety of views varying widely on the question of what standard this Court desires shall be observed. This is illustrated by the following from the decision of the Sixth Circuit Court of Appeals in *U. S. Gypsum v. Consolidated*, 130 Fed. (2) 888, 892:

> "Much difficulty has, of course, been experienced by the courts in determining what improvements lie within the expected skill of the art. We adverted to this in *Cleveland Trust Co. v. Schriber-Schroth Co.*, 6 Cir., 92 F. 2d 330, 334. Older cases are not very helpful. The patent law is presently in a state of flux. Much water has flowed over the patent dam and we must recognize as have other courts and our own (*Cleveland Trust Co. v. Schriber-Schroth Co.*, 6 Cir., 108 F. 2d 109) 'the high standard demanded for invention by the decisions of the Supreme Court in recent years,' (*Buono v. Yankee Maid Dress Corp.*, 2 Cir., 77 F. 2d 274, 276). We cannot 'ignore the fact that the Supreme Court, whose word is final, has for a decade or more shown an increasing disposition to raise the standard of originality necessary for a patent,' (*Picard v. United Aircraft Corp.*, 2 Cir., 128 F. 2d 632, 636), and that it is our 'duty, cautiously to be sure to follow not to resist.' (*Perkins v. Endicott Johnson Corp.*, 2 Cir., 128 F. 2d 208, 218). This is imperative even though *we are unable to go the whole way with Judge Learned Hand* in his observation in the Picard case, *supra*, if correctly interpreted in the concurring opinion in that case as 'a negative test' by which it is determined that 'nothing is an invention which is * * * progress * * * through trial and error.' We remember that the pat-

ent law rewards both invention and discovery and that genius has well been defined as 'an infinite capacity for taking pains.' If the story of Edison's long continued search for an incandescent lamp filament be true, his genius responds to the definition."

Here it is to be noted that Judge Simons, who wrote the opinion, announced that the Court of Appeals in the Sixth Circuit is "unable to go the whole way with Judge Learned Hand" who spoke for the Second Circuit Court of Appeals. This is a direct pronouncement by the Sixth Circuit Court of Appeals that it is in disagreement with the Second Circuit Court of Appeals on the subject.

The District Court Decided the Case "Objectively" in Accordance with the Recommendation of the Commission:

The District Judge said (R. p. 434):

"The evidence adduced during the trial disclosed that the patentee, Ingwer, ever since women decided to wear shoes with wooden heels, *made repeated and numerous attempts to produce a rubber heel or a combination of a rubber heel and some other substance* which would work satisfactorily when attached to the wooden heel. *All prior attempts over a period of ten years had been unsuccessful.* Testimony disclosed that others as well as Ingwer sought the solution of the problem but apparently failed. Numerous methods were described by which skilled workers in the trade experimented. *The history recited showed a long and painstaking search to bring to the public the product which evidently was received with favor, and that it supplied a demand which had existed.* It further demonstrated that the article patented was not a mere obvious and clearly apparent step taken by Ingwer." (Thus deciding against the subjective test.)

"As stated, when the lift manufactured by the Plaintiff under the Ingwer patent *was introduced to the critical requirements of women, it was accepted as satisfactory.* The evidence is clear that the product enjoyed a high degree of commercial success, not as the

result of advertising but because the women users expert in the judging of the success of the item were satisfied that it fulfilled their requirements and unusual demands. The Defendant who copied the lift manufactured by the Plaintiff shared in the commercial success attained.

"Summarized: **A history of existing demand unsupplied, of prior effort and failure, of taking a step not obvious and apparent, a favorable public reception when put on the market, commercial success and duplication by others, all bring this court to the conclusion that the Plaintiff's product possesses patentable novelty and invention.**"

The District Court found (R. p. 455):

"7. The patentee, Ingwer, ever since women decided to wear shoes with wooden heels, made repeated and numerous attempts to produce a rubber heel or a combination of a rubber heel and some other substance which would work satisfactorily when attached to the wooden heel. *All prior attempts over a period of ten years had been unsuccessful. Others skilled in the art sought the solution to the problem but failed. Skilled workers in the trade experimented unsuccessfully by numerous methods.* There was a long and painstaking search to bring to the public the product of the patent in suit, which when produced, was received with favor, and *supplied a demand which had long existed.* The article patented was not a mere obvious and clearly apparent step taken by Ingwer, and did not spring naturally from the expected skill of the art.

"8. When the lift manufactured by the plaintiff under the Ingwer patent was introduced to the critical requirements of women, it was accepted as satisfactory. The product enjoyed a high degree of commercial success, not as the result of advertising, but because the women users expert in the judging of the success of the item were satisfied that it fulfilled their requirements and unusual demands. The defendants, who copied the lift manufactured by the plaintiff, shared in the commercial success attained."

The Court of Appeals Decided the Question "Subjectively" or Contrary to the Recommendation of the Commission:

The Court of Appeals said (R. p. 488):

> "Besides the suggestions in this specialized art itself, it *must have been perfectly obvious to those working in rubber*, that fibre and rubber could be successfully bonded by vulcanization. The practices of the great tire companies in uniting webbed fabric and later cord fabric to rubber by vulcanization, which permitted utilization both of rubber resilience and the restraint of fibrous material (*Firestone Tire & Rubber Co. v. U. S. Rubber Co.*, 79 Fed. (2d) 948), must be adjudged as within the knowledge of the art with which we are dealing."

The members of this Court are familiar with the controversy to which the Commission refers and which has raged through the Press, the Courts, the engineering and scientific societies and fraternities, the patent bar, the manufacturing business world, and elsewhere for some years past, regarding the value of the American patent system, past, present and future, what, if any, changes should be made in it, and if any are to be made, how they should be made. We think it is fair to say from some of the dissenting and other opinions of this Court that this Court has, and does, appreciate not only these controversies, but has appreciated the need of investigation and report as to their value, the ways to determine the controversy, and the methods of settling them.* Certainly the President

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* For example, we find in opinions written by the Justices of this Court such expressions as the following written by Mr. Justice Frankfurter in the *Marconi* case (11 L. W. 4535):

> "I have little doubt, in so far as I am entitled to express an opinion, that the vast transforming forces of technology have rendered obsolete much in our patent law. For all I know the basic assumption of our patent law may be false, and in-

(*Continued on next page*)

of the United States has appreciated all of these things for, as we have said, he appointed the Commission to investigate these questions and determine them, and that the Commission has done. We must all recognize that the Commission has devoted more time and effort, and more careful consideration, to these questions than anyone has ever devoted to them, or than anyone can devote to them. We must recognize in their Report sound recommendations upon these questions based upon these investigations. It would seem to us as members of the Bar, and we assume that it will seem to the members of this Court, as members of the Bench, that it behooves us to accept these recommendations and as expeditiously and as economically as possible aid in the establishing of the policies and machinery for making them effective and for carrying out the recommendations of the Commission, no matter whether we may agree or disagree with some of the Commission's conclusions and recommendations.

The objective method of determining the presence of invention as against mechanical skill is obviously a sound method even independently of the recommendation of the Commission because fundamentally it is predicated, in part at least, upon the failure of mechanics to solve the problem and is, therefore, fact evidence that its solution was not within the skill of the mechanic. The presence of this element or factor in the objective test was found by the District Court and recognized by the Court of Appeals who made the following comments upon it (R. p. 485):

(*Continued from preceding page*)

ventors and their financial backers do not need the incentive of a limited monopoly to stimulate invention. But whatever revamping our patent laws may need, it is the business of Congress to do the revamping. We have neither constitutional authority nor scientific competence for the task."

The Commission has answered all these questions and dispelled all these doubts.

"It is urged that this problem, though recognized in 1918, was not solved until the Ingwer patent issued in 1928, although much effort was expended for ten years both by Ingwer and others in search of solution."

and (R. pp. 487-488):

"The appellee says that forcing the edge of the rubber lift always against the edge of the heel with enough pressure to seal the seam, maintaining this situation during the flexing and unflexing of the heel in response to the tread of the walker, and at the same time limiting this action so that it would not dislodge the edges of the fabric, required a very careful reconciling of antagonisms to provide a kind of automatic force in the lift that would maintain the seam sealed under these conditions and not force the fabric out beyond the edge of the heel; that this was accomplished by a molding and vulcanizing which resulted in a bond between two heterogeneous materials without disruption of either or of the joint."

The presence of the other items or factors necessary for the determination of the question objectively were found as matters of fact in the above quoted findings of fact made by the District Court.

Furthermore, the high importance of the patent system and its proper administration must be accepted from the findings in the Report of the Commission which we have quoted above.* These being accepted, it is equally neces-

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* These findings confirm the findings of the Senate Monopoly Investigating Committee, headed by Senator O'Mahoney, and handed down about January, 1939, which are as follows:

"1. There seems to be a general agreement by these witnesses, as well as by those who previously testified at the Department of Justice hearings some weeks ago, that inventors and business still need the protection and stimulation of patents.

* * * * *

"the patent system has been of inestimable benefit to the country in promoting industrial and scientific development,

(*Continued on next page*)

sary that the District Court be sustained and the Court of Appeals be reversed in order to forward the declared purpose of the Commission that the American patent system, which has accomplished so much and offers so much more, should be forwarded. Indeed, it is apparent from the decision of the Court of Appeals that that Court would not have come to the conclusion it did on the question of patentability if it had had the Report of the Commission before it. The discussions of the Court show that it was in serious doubt on the question and only resolved against the patentee because of views regarding the value of the American patent system then prevalent which are, and must be, dispelled by the Report of the Commission.

Therefore, we maintain that we present here a question of greater public interest than has existed in the patent law since the laws were first enacted, and that the Court should grant this Petition, take up the case, affirm the District Court and reverse the Court of Appeals.

We have already quoted that portion of the opinion of the Commission which finds that the confusion due to the uncertainty as to what is and is not invention "threatens the usefulness of the whole patent system and calls *for immediate and effective remedy.*" We have also cited those parts which find that the American patent system has

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(*Continued from preceding page*)

and may be regarded as one of the principal causes of American industrial supremacy,"

* * * * *

"(6) The fact that patents are keystones in many very important industries has been brought home to us with great emphasis. I doubt whether I had realized their significance as a primary force in the operations of the economic system."

* * * * *

"(7) There was practically unanimous agreement among the witnesses that Congress, by the enactment of the Patent Law, has given this country a system far superior to that which exists in any other country."

promoted and encouraged invention which has resulted in promotion of the public welfare, the raising of the standards of living of the public, and increasing prosperity and business. Perhaps there never was a time when it is so important that we should foster and encourage whatever will promote these enterprises as the present time. In the first place, we are engaged in a war which is fundamentally an inventor's war and, therefore, we ought to encourage invention. The Commission has, after its investigation, told us how this is to be done. There is also much concern about post-war conditions. Nothing could solve the post-war problems like the production of new inventions creating new things to be manufactured, sold and used; indeed many of the post-war planners base their hope for post-war prosperity upon the making of new inventions such as the Commission hopes to encourage.

Careful study and consideration of many comments regarding the administration of the American patent system proves that the basis of those comments is often, and the reasons therefor have arisen from, the failure to adhere in the past to the policy now recommended by the Commission.

Invention in the United States has declined about 28% according to the Patent Office records, declining to a 30% low per capita since 1916, since the conditions noted by the Commission became acute approximately ten years ago. Manifestly, this is a condition that not only should, but must, be remedied if there are to be new products, etc. to be made and marketed to create that post-war prosperity which is so ardently sought and so necessary. The Commission has investigated the causes for this decline, ascertained the reasons, and suggested the remedies.

Mr. Justice Frankfurter is not alone in his comments, made in his dissenting opinion in the *Marconi* case, regarding the inappropriateness of burdening Anglo-American Judges with the duties cast upon them by patent legis-

lation. Yet it is astonishing how well and successfully those duties have been performed when rulings have been bottomed, or bottomed mainly, upon considerations made "objectively." When made objectively these tasks are no more difficult and no more burdening than the consideration, the weighing, and the making of decisions upon fact evidence in any branch of litigation. This is because want and need, prior efforts and failures in a particular art, public acceptance and adoption, commercial success, achievement, and the other criteria of invention, are merely facts whose presence or absence can be detected from ordinary evidence such as is present in any form of litigation.

Mr. Justice Roberts joined Mr. Justice Frankfurter's speculations in the *Marconi* case regarding the need of the grant of patents to encourage invention; both are not only answered by the Commission, but by the Monopoly Investigating Committee which also, and independently of the Patent Planning Commission, made an investigation of the patent system and particularly of this subject. The Committee not only found that

> "inventors and business still need the protection and stimulation of patents"

but that

> "the patent system has been of inestimable benefit to the country in promoting industrial and scientific development, and may be regarded as one of the principal causes of American industrial supremacy."

It is difficult, if not impossible, to successfully challenge the concurring conclusions of the Committee and the Commission. Be that as it may, we will never have conclusions or recommendations that are so reliable upon which to determine our course. It is also, of course, important that both the conclusions of the Commission and of the Committee are affirmed by history and by common sense because history not only records that invention did not

succeed until it was stimulated by the incentive of the limited monopoly, but that few, if any, human enterprises have succeeded without incentive. Inasmuch as the success of invention is inseparably linked to business, it is fair to say that in no case has business ever succeeded without the incentive of a return which would at least be equal to the expenditure and so far no one has ever devised a scheme for offering business, in promoting invented devices, etc., such a return except the patent system. Therefore, the findings and the conclusions of both the Commission and the Committee are not only affirmed by the history of the patent system in particular, but by the history of the human race in general. All of these things are important in this particular case because, as we say, the Commission has found that one of the principal obstructions to the success of the patent system is the decision of cases subjectively instead of objectively.

This Court has had occasion to announce that it would ordinarily accept the concurring findings of fact of two Courts below (*Del Pozo v. Wilson,* 269 U. S. 82, 89; *I. T. S. v. Essex,* 272 U. S. 429). Certainly the concurring findings of fact of both the Commission and the Committee should rate as highly in this Court as the concurring findings of two Courts below.

Mr. Justice Douglas' use of the phrase "flash of creative genius" as a name for the qualities which transcend mechanical skill seems to have been very much misunderstood, since it appears that it has been construed as establishing a "subjective" test for invention. That the subjective method is far afield is further illustrated first by Mr. Edison's comment that genius was "2% inspiration and 98% perspiration" and, second, by a reading of the current book on the Wright brothers. Certainly nobody can dispute that the Wright brothers made an invention when they invented the flying machine. A perusal of this book is convincing that the act of invention of the air-

plane by Orville and Wilbur Wright was 1% inspiration and 99% perspiration.

Mr. Justice Rutledge in his dissenting opinion in the *Marconi* case reflects the wisdom of basing decision in patent cases on history; his views therefore find confirmation and affirmance in the recommendations of the Commission.

These are just some of the instances that illustrate the soundness of the recommendation of the Commission that invention be tested objectively and not subjectively.

Indeed, if this Court would adopt the recommendation of the Commission on this test and make such a ruling in this case, there is no reason why the present Courts could not successfully administer the patent law in the future as they have in the past when adhering to the objective principle. A ruling by this Court, adopting the Commission's recommendation, may make unnecessary some of the other plans proposed by the Commission, such as the creating of a special Patent Court of Appeals.

The right and power of this Court to decide patent cases *objectively* cannot be disputed, as the Court has so held frequently in the past (*Expanded Metal v. Bradford,* 214 U. S. 366, 386; *Loom Co. v. Higgins,* 105 U. S. 580, 591; *Temco v. Apco,* 275 U. S. 319, 324). To effect many of the remedies recommended by the Commission and achieve the ends of both the Commission and the Committee, it is, therefore, only necessary for this Court to pronounce the practices which it followed in these cited cases to be the policy of this Court in the administration of the patent law. Such a declaration would have the effect of at once remedying the situations pointed out by the Commission, adopting its recommendations, and avoiding the delay and expense of legislation which the Commission recommends.

It is, therefore, a matter of great public interest and importance to the public that the confusion on the subject of the test of invention which the Commission finds threat-

ens the usefulness of the whole patent system, be remedied immediately and effectively, as the Commission recommends. This remedy can be immediately and effectively applied by this Court taking up the instant case and affirming the District Court.

Point B.

The Court of Appeals made a twin error; that Court not only decided the question of invention subjectively, but decided it on the basis of what would be subjective in an alien art, i.e., the rubber manufacturer's art; the District Court decided the question objectively in the art to which the invention relates, i.e., the shoemaker's art.

Invention in the shoemaker's art cannot be gauged by the subjective test on invention in the rubber manufacture or engineering art or, to carry the proposition to the extreme, subjectively by the test of invention in the radio engineer's art. To take the position that invention in the shoemaker's art must be gauged by the subjective tests of invention in the rubber engineer's art, or the radio engineer's art, would be to hold that there could be no invention in the shoemaker's art. Indeed, to make the same tests and the same criteria subjectively in all of the arts as are made, for example, in the radio engineer's art, or even in the rubber engineer's art, would be to refuse patents to the workers in a great many arts, such as the shoemaker's art, and to still invention and progress in those arts. The difference between the District Court and the Court of Appeals in the instant case is predicated upon the application by the District Court of the objective tests and criteria applicable to the shoemaker's art and the application by the Court of Appeals subjectively of criteria in the alien art of the rubber workers. The District Court said (R. pp. 433-434):

> "In considering the contention that the patent in question is devoid of patentable novelty or invention,

> *one must approach the subject from the point of view of the art involved.* To weigh the invention of a rubber heel or some other simple article in the same light as an intricate piece of machinery would bring about the almost inescapable result, by comparison, that improvement or advance in the field of products which by their very nature are not complex, do not ever reach the dignity of patentable novelty and patent protection. It appears to the court that the query in this instance should be: *Does the article possess patentable novelty when regarded with the eyes of the shoemaker and tested by his requirements?* (*Kurtz v. Belle*, 280 Fed. 277.)"

The Court of Appeals said (R. p. 488):

> "it must have been perfectly obvious to those *working in rubber.*"

The shoe heel involved is not made entirely of rubber. Rubber is only a part of it. The other part is made of fiber board. If it is proper, because of the presence of rubber, to determine the question of invention by the subjective tests and criteria of the rubber art, then it would be equally logical to make the decision predicated upon the subjective tests and criteria in the fiber-board art. A device, therefore, made of several elements would present a question predicated upon several different sets of tests or criteria unless the fatal course of applying subjectively the same tests and criteria to all arts be applied.

If it is proper to range about among a plurality of arts, then it is imperative that the pleadings advise the arts which will be relied upon that proof may be offered to meet the subjective criteria in the various arts.

If it is proper to decide the question by the standards of a different art, then it was error to exclude the evidence on the subjective tests in that other art and for the Court of Appeals to decide the question without that evidence.

Therefore, if this Court should find the District Court in error in deciding the question "objectively" on the evidence offered, and thinks that the question should be decided on what was within the skill of the mechanic in the rubber worker's art, then this Court should remand the cause to the District Court with directions to reopen the case to admit the evidence on this subject which was excluded by the District Court over the objection of the defendant. Otherwise the case stands decided not only subjectively, but subjectively on the basis of an alien art. Not only is this true, but it stands decided on an issue which was never made up, upon which no evidence was offered by defendant, and on which issue evidence proffered by the plaintiff was objected to and excluded.

If this Court holds that the question should be determined objectively, then the tests and criteria of invention in all arts will automatically become the same.

V.

CONCLUSION.

For the reasons stated in the Petition, and elaborated upon in the brief, we respectfully ask this Court to review and reverse the conclusion of the Court of Appeals for the Sixth Circuit and to affirm the District Court in the Northern District of Ohio, Eastern Division, and to hold that the question of invention and mechanical skill should be decided objectively and not subjectively, as the President's National Patent Planning Commission has recommended.

Respectfully submitted,

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(13)

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In the Supreme Court of the United States

OCTOBER TERM, 1943.

No. 169.

THE I. T. S. COMPANY,
Petitioner,

vs.

SEIBERLING RUBBER COMPANY,
and
THE SEIBERLING RUBBER COMPANY,
Respondents.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI.

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Point B 12

The finding of the Sixth Circuit Court of Appeals that the question of invention be determined and gauged by what is obvious or unobvious in the rubber manufacturers' art was based upon evidence that patentees in the rubber heel art resorted to the use of the skill of rubber manufacturers to produce their heels. This does not constitute use of the "subjective" test, and this whole question is immaterial to the issue herein asserted by petitioner.

Point C 13

The Sixth Circuit Court of Appeals in denial of the Motion for New Trial (Record page 511) concurred with the District Court's ruling (Record page 57) in excluding, at the instance of respondents, evidence as to the alleged difficulties involved in the method or process by which such heels are manufactured, which evidence was excluded on the well-established rule that a patentee is estopped by proceedings in the Patent Office from recapturing a position once relinquished. There is no diversity of opinion in this case or in the Federal Courts on the "File Wrapper Estoppel," and this question is immaterial to the present petition.

Point D 14

It is immaterial that there is diversity of decision between the various courts of appeals concerning the character of the test of invention used or of the standard of invention which this Court has established, because, upon the objective test asserted in behalf of petitioner as the correct one (Petitioner's Brief, page 20), the Sixth Circuit Court of Appeals found against petitioner.

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I.

THE OPINIONS OF THE COURTS BELOW.

The opinion of the District Court is reported in 53 U. S. P. Q. 627, and is reproduced at pages 431 to 438 of the Record.

The opinion of the Sixth Circuit Court of Appeals is reported in 134 F. (2d) 871, and is reproduced at pages 484 to 490 of the Record.

II.

JURISDICTION.

Jurisdiction of this Court to implement the recommendation of the National Patent Planning Commission that the question of invention in patent cases "be determined objectively by the nature of the contribution to the advancement of the art" is not questioned, but jurisdiction of this Court in the present case is denied on the

ground that the Sixth Circuit Court of Appeals in this case decided the question of invention "objectively by the nature of the contribution to the advancement of the art," and hence, there is no issue upon which to review the opinion below. (See: *White v. Johnson,* 282 U. S. 367, 373; *United States v. Hall,* 313 U. S. 50, 52; *Webster v. Cooper,* 10 How., 54, 55; *Triplett v. Lowell,* 297 U. S. 638; *General Talking Pictures Corp. v. Western Electric Co.,* 305 U. S. 124.)

III.

SUMMARY OF ARGUMENT.

POINT A.

There is no diversity of decision between the courts below upon the question of whether presence of invention should be determined "objectively."

POINT B.

The finding of the Sixth Circuit Court of Appeals that the question of invention be determined and gauged by what is obvious or unobvious in the rubber manufacturers' art was based upon evidence that patentees in the rubber heel art resorted to the use of the skill of rubber manufacturers to produce their heels. This does not constitute use of the "subjective" test, and this whole question is immaterial to the issue herein asserted by petitioner.

POINT C.

The Sixth Circuit Court of Appeals in denial of the Motion For New Trial (Record page 511) concurred with the District Court's ruling (Record page 57) in excluding, at the instance of respondent, evidence as to the alleged difficulties involved in the method or process by which such heels are manufactured, which evidence was excluded on the well-established rule that a patentee is estopped by

proceedings in the Patent Office from recapturing a position once relinquished. There is no diversity of opinion in this case or in the Federal Courts generally on the "File Wrapper Estoppel," and this question is immaterial to the present petition.

POINT D.

It is immaterial that there is diversity of decision between the various courts of appeals concerning the character of the test of invention used, or of the standard of invention which this Court has established, because, upon the objective test asserted in behalf of petitioner as the correct one (Petitioner's Brief page 20), the Sixth Circuit Court of Appeals found against petitioner.

IV.

ARGUMENT.

POINT A.

In order there shall be a clear understanding of the National Patent Planning Commission's recommendation that "patentability shall be determined objectively by the nature of the contribution in the advancement of the art and not subjectively by the nature of the process by which the invention may have been accomplished" reference is made to the general discussion under the subject of "Invention" in Chapter III, *Walker on Patents, Deller's Edition*, Vol. I, page 109, and particularly to the following excerpts:

Pages 118 and 119:

> *"No absolute rule by which to determine presence or absence of invention.*
>
> "In delivering an opinion of the Supreme Court, *in January, 1885,* Justice Matthews used some language which may be thought to establish an affirmative rule by which to determine the presence or absence of invention in every case. Speaking of a simple device

which the court held not to be an invention, he said that it 'seems to us not to spring from that *intuitive faculty of the mind* put forth in search for new results or new methods, creating what had not before existed, or bringing to light what lay hidden from vision; but, on the other hand, to be the suggestion of that common experience which arose spontaneously, and by a necessity of human reasoning, in the minds of those who became acquainted with the circumstances with which they had to deal.' (*Hollister v. Benedict Mfg. Co.*, 113 U. S. 59, 72, 28 L. Ed. 901, 905 (1885). See also, *Ford Motor Co. v. Parks & Bohne*, 21 F. (2d) 943, 949, C. C. A. 8 (1927); *Donner v. Sheer Pharmacal Corp.*, 64 F. (2d) 217, 221, C. C. A. 8 (1933), cert. den. 290 U. S. 658, 78 L. Ed. 570 (1933); *Saranac Mach. Co. v. Wirebound Pat. Co.*, 282 U. S. 704, 713, 75 L. Ed. 634, 630 (1930).) This language may be thought to mean that whatever new and useful process, machine, manufacture, composition of matter, or design is *produced by intuition* is an invention, and that whatever such thing is produced by reason is not an invention. But such an interpretation of the language would not be right. Intuition may sometimes reach to a single brilliant result; but intuition can never conceive or correlate the mazes of movements and mechanisms which constitute a modern automatic machine. To enforce such a rule as that hypothetically implied in the language of Justice Matthews would be to deny invention to those marvelous combinations of numerous metallic devices which constitute American automatic machinery, and which work with such complexity and yet with such precision that they seem themselves to be endowed with reason. *But fortunately the supposed interpretation of that language is evidently not the meaning of the court.* The court does not deny invention to all the products of pure reason in the useful arts. It merely finds want of invention in those things which are conceived 'spontaneously and by a necessity of human reasoning' in the minds of those who have their attention directed to the subject.

"In a later case the Supreme Court, speaking by Justice Brown of the meaning of the word 'invention'

said: 'The truth is, the word cannot be defined in such manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty or not. In a given case we may be able to say that there is present invention of a very high order. In another, we can see that there is lacking *that impalpable something* which distinguishes invention from simple mechanical skill. Courts, adopting fixed principles as a guide, have by a process of exclusion determined that certain variations in old devices do or do not involve invention; but *whether the variation relied upon in a particular case is anything more than ordinary mechanical skill is a question which cannot be answered by applying the test of any general definition.' (McClain v. Ortmayer,* 141 U. S. 419, 427, 35 L. Ed. 800, 803 (1891); and also see *City of St. Louis v. Prendergast,* 29 Fed. (2d) 188, 192, C. C. A. 8 (1928).)"

Pages 135 and 136:

"*Determination of invention, after applying objective tests, matter of subjective opinion.*

"In *Kirsch Mfg. Co. v. Gould Mersereau Co., Inc.,* 6 F. (2d) 793, 794, C. C. A. 2 (1925), Judge Hand gave an interesting summary on 'invention' in which he said:

" 'Objective tests may be of value vaguely to give us a sense of direction, but the final destination can be only loosely indicated. An invention is *a new display of ingenuity beyond the compass of the routineer,* and in the end that is all that can be said about it. Courts cannot avoid the duty of divining as best they can what the day to day capacity of the ordinary artisan will produce. This they attempt by looking at the history of the art, the occasion for the invention, its success, its independent repetition at about the same time, and the state of the underlying art, which was a condition upon its appearance at all. Yet, when all is said, there will remain cases when we can only fall back upon such good sense as we may have, and in these we cannot help exposing the inventor to the hazard inherent in hypostatizing such modifications

in the existing arts as are within the limited imagination of the journeyman. *There comes a point when the question must be resolved by a subjective opinion as to what seems an easy step and what does not.* We must try to correct our standard by such objective references as we can, but in the end the judgment will appear, and no doubt be, to a large extent personal, and in that sense arbitrary.'

"Thus it has been settled that the ideal line which separates things invented from things otherwise produced can never be concisely defined; and that *there is no affirmative rule by which to determine the presence or absence of invention in every case*; and that such questions are to be determined by means of several negative rules which operate by a process of exclusion. Each of those rules applies to a large class of cases, and all of them are entirely authoritative and sufficiently clear. To formulate those rules, and to state their qualifications and exceptions, and to classify and cite the adjudged cases from which those rules, qualifications, and exceptions are deducible, is the scope of several sections which follow."

Petitioner, in its Brief, page 18, has itself shown that the established test for invention in the Sixth Circuit Court of Appeals is the objective one as used in *U. S. Gypsum v. Consolidated*, 130 F. (2d) 888 prior to the present case. And in a very recent case, decided since the present one, we find the Sixth Circuit Court of Appeals so stating (*Trabon Engineering Corp. v. Dirkes, et al.*, 58 U. S. P. Q. 97, 100):

"We are likewise aware of the deep concern felt by patent lawyers and research engineers not only over higher standards of invention, but over what in some quarters has been thought to be *an entirely new concept of invention* deriving from *Cuno Corp. v. Automatic Devices Corp.*, 314 U. S. 84, 91 (51 USPQ 272, 275), where it was said that a new device 'however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling.' *We do not interpret the observation as indicating anything*

more significant than that the quality of invention is 'something more' than expected mechanical skill. Nor do we read the phrase as another conscious effort to define the indefinable.

"*Long experience with assailed inventions in trial and on review, led us in humility to the conclusion that the inventive concept is an abstraction impossible to define,* and so for that reason courts have sought for simple rules by which its presence may be detected, and while these have proved helpful they are never absolute; *that long recognition of an existing problem in any art, and the advantages to accrue to an industry from its solution, have been considered as highly persuasive of invention when success is finally achieved;* that sometimes achievement is revolutionary, but more often an inventor begins where others have left off, and *perceives the vital forward step to which predecessors have been blind. Cleveland Trust Co. v. Schriber-Schroth Co.,* 92 F. (2d) 330-334 (35 USPQ 475, 477-480). Somewhat similar commentary was indulged in in *A. O. Smith Construction Co. v. Petroleum Iron Works,* 73 F. (2d) 531 (24 USPQ 183), at an earlier date. We have yet to encounter an invention which, prior art considered, seems to have sprung fully matured from the brow of genius. Whether in the great inventions adjudged patentable in the past the inventive concept arrived with the blinding suddenness of the lightning's flash, or from 'the projection of the imagination into the realms of the unknown,' or whether they were the product of painful and laborious experimentation apparently condemned as indicia of invention in *Picard v. Aircraft Corp.,* 128 F. (2d) 532 (53 USPQ 563) (CCA 2), we do not know. Some were undoubtedly the product of accidental discovery. At least so thinks Dr. Kettering, Chairman of the National Patents Planning Commission. Certain it is that Edison placed little confidence in inspiration when he defined genius as '2% inspiration and 98% perspiration.' *Of course, routine experimentation leading to a reasonably expectable result is not invention.* Conversely the most brilliant and inspired conception is not invention unless it can be reduced to

practice by novel means or method so that its utility may be demonstrated, *Reo Motor Car Co. v. Gear Grinding Machine Co.*, 42 F. (2d) 965, 968 (6 USPQ 9, 12) (CCA 6). All we can say in respect to the present problem is that *measured by the conventional tests by which the presence or absence of invention has been determined*, we are of the view that Hillis achieved a result *beyond the reach of routine skill in the art*, and that the claims in suit denote invention."

Thus, it appears there has been no deviation by the Sixth Circuit Court of Appeals from its long established use of objective test for invention.

Examining now the opinion here in question, we find that the Sixth Circuit Court of Appeals did not in this case deviate from its usual process. Referring to the opinion (Record page 486 *et seq.*) the Court in reaching its conclusion on the question, sought:

"* * * to ascertain *just what it was that Ingwer did that had not, in essence, been done before, and whether it denoted invention or was within expected routine skill of those laboring in the art.* The concavo-convex form of rubber heel was, of course, not the invention of Ingwer, nor does he claim it to be. In *I. T. S. Co. v. Essex Co.*, 272 U. S. 429, 434, it is pointed out that it is a characteristic of the concavo-convex type of rubber heel, because of the tendency of rubber to resume its original curved form to keep tightly pressed against the heel,—a characteristic called the 'tight edge effect'—and that it was referred to as early as 1889 in Ferguson's patent No. 638,228. The Tufford heel, reissue patent No. 14,049, owned by the present appellee and by it litigated in the Essex case and elsewhere, is of the concavo-convex type. Its merit in sealing the joint between lift and heel was widely proclaimed. It was old to insert an inextensible plate of metal, leather, or fabric, between the rubber lift and the wooden heel, as shown by the patents of Warren No. 1,564,158, No. 1,681,961, and Ross No. 1,604,659. The examiner pointed out that there was no patentable distinction between molding and vul-

canizing fabric to a portion of the concave surface of a rubber heel, and covering its entire surface by such molding and vulcanizing, especially as Roberts shows the application of a plate to the entire area of heel surface. No inventive concept resides in the mere thought of a unitary construction of rubber and fabric. This was disclosed in Lucier No. 1,439,-564, December 19, 1922, and Feinstein in his patent, also discloses such unitary construction.

"Feinstein's heel lift is flat, but it may not be claimed, and perhaps is not, that to give the Feinstein heel the well-known conventional concavo-convex shape, denoted an inventive concept. *What then, was Ingwer's contribution to the art?* The appellee says that forcing the edge of the rubber lift always against the edge of the heel with enough pressure to seal the seam, maintaining this situation during the flexing and unflexing of the heel in response to the tread of the walker, and at the same time limiting this action so that it would not dislodge the edges of the fabric, required a very careful reconciling of antagonisms to provide a kind of automatic force in the lift that would maintain the seam sealed under these conditions and not force the fabric out beyond the edge of the heel; that this was accomplished by a molding and vulcanizing which resulted in a bond between two heterogeneous materials without disruption of either or of the joint. But Feinstein also bonded the two heterogeneous materials. His use of the term 'vulcanizing' may be ambiguous in view of the practical construction that he and his licensee, the Day Wood Heel Company, put upon the patent, for they united the rubber and fiber by rubber cement. While this is sometimes referred to as a 'vulcanizing cement' and the operation as 'vulcanizing,' it is undoubtedly not as good a bond as vulcanizing and molding.

"But whatever may have been Feinstein's practice, it is clear that his patent teaches a unitary combination of rubber and fiber. Granted that Feinstein's bond between the two materials is less permanent than Ingwer's, because of the tendency of flexing to disintegrate the cement and so loosen the bond, the vulcanization of

fiber and rubber was the invention neither of Feinstein nor Ingwer. *Besides the suggestions in this specialized art itself*, it must have been perfectly obvious to those working in rubber, that fiber and rubber could be successfully bonded by vulcanization. The *practices of the great tire companies in uniting webbed fabric and later cord fabric to rubber by vulcanization, which permitted utilization both of rubber resilience and the restraint of fibrous material* (*Firestone Tire & Rubber Co. v. U. S. Rubber Co.*, 79 Fed. (2d) 948), must be adjudged as within the knowledge of the art with which we are dealing. The multiple plies were widely advertised. It is idle to urge that the automobile tire is in a non-analogous art. *When inventors of rubber heel lifts sought to exploit their patents they turned naturally to the tire companies for manufacture of their devices, Nerger to U. S. Rubber Co., Tufford to Miller, Feinstein or its licensee, to Firestone.* The essence of the Ingwer concept, therefore, does not reside in the use of the concavo-convex form, the insertion of non-extensible fabric between lift and heel, or in joining rubber and fabric into a unitary construction. All these things had been done. *We understand, of course, that these are combination claims and that a valid patent may issue for a new combination even though all its elements be old. But this is true only where the quality of invention is exercised in the combining to bring about a new mode of operation and produce a new and useful result.* Ingwer improved upon Feinstein *by utilizing the well understood method of vulcanization to create a better bond* between the two elements of his patented combination. Such improvement was advance only in *degree*, and as such must yield to the rule, *that a mere carrying forward of a new or more extended application of the original thought, a change only in form, proportions, or degree, the substitution of equivalents doing the same thing in the same way by substantially the same means with better results, is not such invention as will sustain a patent. Smith v. Nichols*, 21 Wall. 112, 119; *Glue Co. v. Upton*, 97 U. S. 3; *Dunbar v. Myers*, 94 U. S. 187, 199; *Railroad Supply Co. v. Elyria Iron Co.*, 244 U. S.

285, and in our own court *Ford Motor Co. v. Ohio Stamping & Engineering Co.*, 56 Fed. (2d) 807, 808; *Blackmore v. Ford Motor Co.*, 56 Fed. (2d) 806.

"Nor is there wanting in the history of the art, as disclosed by the record, facts that compel conclusion that the inventor but substituted new materials for old in a conventional combination. While such substitution may have resulted in a superior article it was not necessarily a patentable invention. *Florsheim v. Schilling*, 137 U. S. 64, 76; *Kemper-Thomas Co. v. J. P. Gordon*, 67 Fed. (2d) 478 (C. C. A. 6); *Firestone Tire & Rubber Co. v. U. S. Rubber Co., supra. Much was made of the commercial success of the Ingwer heel lift and undoubtedly it made a deep impression upon the court below, but the appellee was already a highly successful manufacturer of rubber reels with an established goodwill throughout the country.* Its phenomenal growth, based upon the Tufford heel, is fully disclosed in the opinion of the late Judge Westenhaver, adopted by this Court in *Fetzer & Spies Leather Co. v. I. T. S. Rubber Co.*, 260 Fed. 939, wherein it is shown that without advertising or soliciting salesmen, its business grew from a production of a few thousand heels a month to over 2¼ million in three years, and with an initial capital of $30,000 in 1915, its undivided profits in 1918 were $800,000 after net earnings in the previous year of $482,000. *It is little wonder that the appellee, with an extensive advertising campaign, could readily market an improved heel, and its success is little tribute to the inventive character of the improvement. Standard Parts Inc. v. Toledo Pressed Steel*, 93 Fed. (2d) 336 (C. C. A. 6), aff., 350 U. S. 350. Likewise does this history obscure the picture sought to be drawn of the controversy as one between an enterprise of a poor but honest cobbler continued by two shoe-clerks after his death, and a powerful rubber company with highly developed selling and advertising talents. We are of the opinion that the claims in suit are invalid for want of invention."

Nothing could be clearer from the foregoing quotation than that the Sixth Circuit Court of Appeals used the ob-

jective test "by the nature of the contribution to the advancement of the art"; and at no point in its decision upon the question of invention did it base its opinion upon "the nature of the process by which the invention may have been accomplished." The opinion had nothing to say concerning inventive "intuition" or the "flash of genius." In fact, the Record in this case shows that respondents did not attempt to bring out in the record or to urge before the courts below that there was any "process by which the invention may have been accomplished" which indicated lack of invention. The respondents in both courts below relied upon well-established principles applied by this Court in cases such as *Atlantic Works v. Brady*, 107 U. S. 192, *Smith v. Nichols*, 21 Wall. 112, and *Gardner v. Herz*, 118 U. S. 180, which cases exemplify a finding of lack of invention by objective rather than subjective tests.

POINT B.

Petitioner's Brief, page 29, treats of the rubber manufacturers' art as being "alien" to the shoe-maker's art in respect to the production of rubber heels. Such is not the fact. As stated by the court below (Record page 488 *et seq.*):

> "It is idle to urge that the automobile tire is in a non-analogous art. *When inventors of rubber heel lifts sought to exploit their patents they turned naturally to the tire companies for manufacture of their devices,* Nerger to U. S. Rubber Co., Tufford to Miller, Feinstein or its licensee, to Firestone."

Moreover, it is a matter of common knowledge that rubber heels, as *used* by cobblers, are *manufactured* by rubber companies. These two arts may therefore not be divorced from each other as the District Court had considered proper. In reversing the District Court, the Sixth Circuit Court of Appeals considered that designers of rubber heel lifts would naturally turn to tire and rubber

companies as it was proved Feinstein and Day Wood Heel Company both did in the instant case. This is not testing an alleged invention "by the nature of the process by which the invention may have been accomplished." This whole question of analogy of the arts is objective and therefore immaterial on the principal question asserted by petitioner.

POINT C.

It is well settled by the decisions of this and lesser Federal Courts (See *Keystone Co. v. Northwest Eng. Co.*, 294 U. S. 42 and *Valjean et al. v. Perfection Stove Co.*, 103 F. (2d) 60) that a patentee may not in an infringement suit recapture a position which he relinquished in the proceedings by which the patent was obtained. The patentee, Ingwer, having conceded that the method of molding and vulcanizing composite articles of rubber and fiber is old, by the cancellation of his method claims (Record, page 252), could not in this suit be permitted to offer proof showing that this method of making composite heels is new, in support of the article or product claims which he retained. Obviously, the product claims, upon these facts, should be interpreted, as was done by both courts below, as purportedly covering a heel of certain composition and shape *as made by a concededly old method.*

Thus, there was not the slightest diversity of opinion between the District Court and the Sixth Circuit Court of Appeals on this point. The District Court sustained respondent's objection and the Court of Appeals denied petitioner's Motion for New Trial (Record page 511) which was based upon the alleged error of the District Court in excluding the evidence.

This matter of estoppel is entirely alien to the question raised by the present petition. There is no diversity of opinion throughout the entire Federal Judiciary upon the question of "File Wrapper" estoppel. As stated by

Walker on Patents, Deller's Edition, Vol. II, Sec. 249, page 1215, upon the authority of many cases:

> "Where an applicant, on the rejection of his application inserted in consequence of that rejection, limitations and restrictions into his specification, for the purpose of obtaining his patent, he cannot, after he has obtained it, claim that it shall be construed as it would have been if such limitations and restrictions were not contained in it. (Citing cases.)"

Here again the situation existing in the present case would not be resolved by decision of this Court upon the issue of the "objective test" versus the "subjective test."

POINT D.

The approach of the Sixth Circuit Court of Appeals to the question of invention was "objective" rather than "subjective." It found the petitioner had failed, by satisfactory evidence, to meet the defense of lack of invention; had failed to establish that the patentee had "taken a step, not obvious and apparent" in the production of a composite heel like Feinstein's but of the concavo-convex shape; that the concavo-convex heel was old and well-known when the Feinstein heel was produced; and that Ingwer used as the process for producing that heel one, concededly old and well-known, for securing rubber and fiber together in a unitary structure by molding and vulcanizing.

The court below was not impressed by the contentions of the petitioner respecting the "existence of a demand unsupplied" or the proof of "prior effort and failure" which, considering the almost precise anticipation by each of Feinstein and Lucier, both of whom had carried out successful commercial operations, was of a very flimsy nature.*

---

* The Feinstein heel was on the market when this case was tried, and presumably still is.

Nor was the court convinced that the favorable public reception of the Ingwer heel when put on the market and the commercial success thereof were due to the presence of invention. The court found upon the evidence that the commercial success was due to other causes.

Petitioner cannot complain. The Court below used petitioner's own test of invention, and found none.

V.

CONCLUSION.

The opinion of the Sixth Circuit Court of Appeals in *U. S. Gypsum v. Consolidated, supra,* cited on pages 18 and 19 of petitioner's brief, establishes that *prior to the recommendation of the National Patent Planning Commission,* the Court of Appeals had rejected the subjective test for invention, "nothing is an invention which is * * * progress * * * through trial and error." The opinion of the Sixth Circuit Court of Appeals in *Trabon v. Dirkes et al., supra, rendered since the recommendation,* indicates that the Circuit Court of Appeals had long been in agreement with the National Patent Planning Commission recommendation respecting use of the objective test. The opinion, the review of which petitioner seeks in this Court, applied the objective test in the same way as was done by the same court, *both before and after the report of the Commission.* The Sixth Circuit Court of Appeals used the petitioner's own test. This, therefore, is not a proper case for determination of any issue raised by the petition.

Accordingly, respondents urge that the petition be denied for want of jurisdiction, as seeking the answer to an academic question bearing no relation to the facts of the case.

Respectfully submitted,

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In the Supreme Court of the United States

OCTOBER TERM, 1943

No. 468

THE [illegible] COMPANY,
Petitioner,
vs.
SEIBERLING RUBBER COMPANY,
and
THE SEIBERLING RUBBER COMPANY,
Respondents.

REPLY BRIEF

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In the Supreme Court of the United States

OCTOBER TERM, 1943.

No. 169.

THE I. T. S. COMPANY,
Petitioner,

vs.

SEIBERLING RUBBER COMPANY,
and
THE SEIBERLING RUBBER COMPANY,
Respondents.

REPLY BRIEF FOR THE PETITIONER.

Now Comes the Petitioner and asks leave to file this Reply Brief and for its consideration by the Court.

POINT A.

The citations by Respondents constitute a saga of the confusion among the patent tribunals which the Commission deplores and seeks to remedy by its recommendation of the immediate adoption and use of the objective test.

The notations by Judge Hand in the *Kirsch* case, appearing at page 6 of Respondents' Brief, to the effect that the decision of the question of invention is "*to a large extent personal, and in that sense arbitrary*" is precisely the practice which the Commission says has led to the evil, for as long as the decision is personal, the decisions vary with the personalities and the personal views of the different tribunals. So long as the decisions are "arbitrary" they depart from reason and the right.

The unsoundness and the evil results of the present system discussed by Judge Hand are reflected in the text-

books. Thus at page 5 of Respondents' Brief, Respondents quote from *Walker on Patents,* one of the standard text-books on patent law, to the effect that the question of invention and mechanical skill—

> "cannot be answered by applying the test of any general definition."

It is this general definition which the Commission has supplied in recommending the objective test. What is needed is authority of this Court to apply that general definition.

The Commission repeated what Judge Hand and Walker have said when the Commission said:

> "Many different and unrelated tribunals now are forced to make their *individual* decisions, among them being the Patent Office, the several District Courts, the various Courts of Appeal and the Supreme Court."

Judge Hand's feelings are repeated by the Commission when the Commission said:

> "No other feature of the law is more destructive to the purpose of the patent system than this existing uncertainty as to the validity of the patent."

Judge Hand went on to say:

> "There is no affirmative rule by which to determine the presence or absence of invention in every case."

The Commission provides such a rule and has recommended the immediate adoption of the objective test for that purpose. Thus the Commission says:

> "There should be a uniformity in the grant and treatment of patents. The present confusion threatens the usefulness of the whole patent system and calls *for an immediate and effective remedy.*"

Respondents cite the decision of the Sixth Circuit Court of Appeals in *Trabon v. Dirkes* (136 Fed. (2) 24). This decision, in which resort was had to the objective test to determine the question of invention by a separate group of Judges from those who sat in the instant case (except

for Judge Simons), establishes either that the Court must have, in the *Trabon* decision, had the benefit of the Report of the Commission or else that the confusion on the subject which the Commission, Judge Hand, Walker, and others, have pointed out as current among all of the Patent Tribunals, is even current among different groups of Judges on the same Court of Appeals.

In behalf of the first conclusion it is to be noted that the decision in *Trabon v. Dirkes* was handed down June 4, 1943 and contains a reference to the Commission and its Chairman. The Report of the Commission was transmitted to Congress by President Roosevelt on June 18, 1943. That Court could not have had the views of the Commission when the decision in the instant case was rendered.

If the other conclusion is correct, then the confusion and diversity of views among the different sets of Judges on the same Court of Appeals is additional reason for granting our Petition in the instant case.

Respondents seem confused about the difference between the subjective test and the objective test, notwithstanding these two methods of reasoning and arriving at conclusions have been the subject of discussion not only throughout patent litigation for many years, but among philosophers and others with respect to general questions. The following excerpts from Webster's New International Dictionary (1931) are helpful, if not clarifying, on the subject:

> "The modern meanings of subjective (b above) and objective are mainly derived from the Kantian conception of the subject *of experience as the necessary condition of reality.*
>
> * * * * *
>
> "In the philosophy of the mind, subjective denotes what is to be referred to the thinking object, the ego; objective, what belongs to the object of thought, the nonego."

It at once becomes apparent that the subjective is personal and arbitrary, as Judge Hand characterized it in the *Kirsch* case, and the objective is predicated upon experience. The District Court in the instant case predicated his finding of the presence of invention upon evidence of experience and accepted the experience as the necessary condition of the reality, all outside of the ego, or personality. On the other hand, the Court of Appeals decided the question because the Court thought, as a matter of its indwelling views, that what was done was within the skill of the rubber workers. (The word "ego" used by the dictionary and by us is not used in the sense of vanity, of course, but in the sense of the person.)

An outstanding example is the decision of whether the world is flat or round which was presented to so many people in Ancient and Medieval times. Decided subjectively upon the basis of what the person or ego thought and saw with the eye, the earth was held to be flat. Decided upon the basis of the experience of people who had gone around the world and the experience of the astronomers, navigators and other scientists, the application of the objective test resulted in the decision that the world was round.

The sciences, the mechanics and invention are replete with such analogies, for the same thing might have been said about the question of whether the sun revolves around the earth or the earth turns in the face of the sun. The subjective test convinced the Ancients and people in the Middle Ages, and some people in the present day, that the sun moves around the earth. The objective test proves the error of this.

Another example is the "falling of the dew." Everybody was firmly convinced until recent times that "the dew falls." Yet the dew does not fall, notwithstanding the subjective test is convincing on the subject. Not only does the dew not fall, but the dew rises, as the objective test has shown and proved.

Many even more convincing examples are to be found in medicine. For a long time it was believed that many diseases, such as tuberculosis, were hereditary, and others, such as yellow fever, resulted from contact. These conclusions were necessarily based upon subjective tests. Investigation, experience, experiments, etc. have taught us the error of these subjective test conclusions, and through objective tests the truth has been learned. Once the truths were learned through objective tests, the medical profession was prompt and vigilant in rejecting the erroneous subjective test conclusions and adopting the correct objective test conclusions.

The number of such analogies is legion. We have cited these particular instances because they relate to more familiar subjects. If, of course, the question of the shape of the earth, the relation of the earth to the sun, and the source of the dew had continued to be decided on the subjective test, we would still have been morassed in the original errors. If the medical profession had persisted in adhering to subjective test diagnosis, we would still have been "dying like flies." There is no more reason why the question of invention should be continued to be decided upon the subjective test when the objective test is available than there is that we should continue to think the world is flat, the sun moves around the earth, the dew falls or to "die like flies." There is no reason in persisting in error when the truth is available. There is no more reason for persisting in the error and the confusion which the Commission points out, now that they have been hounded down and isolated by the Commission, than there would be in persisting in the errors regarding astronomy, meteorology and medicine to which we have referred.

The lengthy quotations in the Respondents' brief from the opinion of the Court of Appeals in the instant case are merely arguments and discussions of the Court leading up to the final and fatal conclusion that—

"it must have been perfectly obvious to those working in rubber."

This is a subjective test of subjective tests. Not only did the Court decide the question within the "ego," but the Court was not very certain about it, for the Court did not say that it was obvious to those working in rubber, which is the language generally used in the application of the subjective test, but the Court used the word "must," indicating uncertainty. It is also noted that the subjective test was not applied to the art to which the invention relates, but to the rubber art.

POINT B.

The mere fact that a part of the heel lift constituting the invention of the patent in suit is made of rubber does not make the shoemaker's art coincident with the rubber art.

It would be just as reasonable to contend that the steel-maker's art is identical with each of the arts in which steel is employed, including the printing press art, the agricultural machine art, the automatic screw machine art, the automobile art, etc., *ad infinitum*.

It would be just as reasonable to say that the tanner's art was identical with the arts in which leather is used, such as the shoe art, the belt art, the saddle art, the harness art, etc., *ad infinitum*.

It would be just as reasonable to say that the plastic art was identical with the innumerable arts in which articles are made of plastic.

In all of these cases the production of the material such as steel, rubber, leather and plastic are largely chemical or elemental otherwise, whereas the production of the articles from the materials is almost entirely mechanical. To take the position that there is identity between arts merely because one art involves the manufacture of a material used in the other art would result in almost as much

confusion and disaster as the use of the subjective test instead of the objective test, as the Commission points out, so that to cure the one and institute the other would be, to use a colloquial expression, "getting out of the frying pan into the fire."

POINT C.

There is nothing to the file wrapper estoppel claim. Neither Court below agreed with the Respondent's contention on the subject. Thus there are concurring opinions below rejecting it. Review thereof is not sought here.

POINT D.

Respondent's discussion emphasizes the impression made upon the District Court by the evidence upon which the objective test is based and the scant attention given this evidence by the Court of Appeals.

CONCLUSION.

The patent system has been, and is, a valuable entity, as the Commission has found.

This patient is sick, as the Commission has found, and as is established by the 28% decline in invention in this country in the last ten years to an all low per capita.

The President recognized that this valuable patient is sick and appointed the Commission to perform the function of the doctor to diagnose the case and to recommend a remedy.

This the Commission has done, adding that the remedy should be applied immediately.

In the medical profession, in the engineering profession, and in any other profession, the remedy would be applied forthwith.

Our Petition is an application that the law profession be as vigilant in applying remedies as any other profession.

Respectfully submitted,

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